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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/677,168 | 10/02/2003 | Naoyasu Miyagawa | JEL 28567RE-G | 7831 |
| 7590 | 12/23/2004 | | EXAMINER | |
| James E Ledbetter Esq Stevens Davis Miller & Mosher LLP 1615 L Street NW Suite 850 P O Box 34387 Washington, DC 20043-4387 | | | HINDI, NABIL Z | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2655 | | |
| DATE MAILED: 12/23/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/677,168 | MIYAGAWA ET AL. |
| | Examiner | Art Unit |
| | NABIL Z HINDI | 2655 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 25-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 07/740,629.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/17/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

In response to applicant's pre-amendment dated Oct 02, 2003. the following action is taken:

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

Claims 25-29 are rejected as being based upon a defective reissue application under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claims 25-29 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1448, 45 USPQ2d 1164 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of

35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The recapture rule "prevents a patentee from regaining through reissues the subject matter that he surrendered in an effort to obtain allowance of the original claims". *In re Clement*, 131 F.3d 1448, 45 USPQ2d 1164 (Fed. Cir. 1997). Reissued claims that are broader than the original patent's claims in manner directly pertinent to the subject matter surrendered during prosecution are impermissible. (*Mentor*, 998 F. 2d at 996, 27 USPQ2d at 1525).

During the '581 patent prosecution, the rejected claims 1 and 6 (in addition to claims 11, 16, 21 and 26) were canceled and claims 2, 4, 5, and 7-9 were amended (see paper# 6 filed Nov. 17, 1992) to overcome the prior art rejection. The newly added limitations included for example, "N optical heads, N being greater than or equal to 2"; objective lenses "whose aberration have respectively been corrected for said N disc substrates having different thickness"; "a plurality of" photo detecting means, "control means for allowing" and "control means for providing said control signal to said selecting means and for allowing the light emitting means for" which have now been removed from the present reissue application. This constitutes an improper recapture of the claims, see *Pannu v. Storz Instruments, Inc.* 258 F.3d 1366, 59 USPQ. 2d 1597 (Fed. Cir. 2001).

The broadening aspect of the reissued claims is directly related to the surrendered subject matter. The pending independent reissue claim 25 now recite "converging optical system having at least one of" (claim 25 lines 19 and 20) and not the more narrow language added by the amendment filed November 17, 1992: "N converging means (objective lenses) whose aberration have respectively been corrected for said N (N>2) disk substrates having different thicknesses".

Furthermore, the reissue claim 25 is now broader in some aspects in that claim 25 do not recite the limitations “disk discriminating means for discriminating the thickness of the disk substrate of a loaded optical disk and for generating a discrimination signal” nor recite the limitation “control means for selecting the optical head having the objective lens in which the occurrence of the aberration due to the disk substrate is smallest in accordance with the discrimination signal” as amended during the prosecution of the ‘581 patent application to overcome the prior art rejection.

The reissue claims recite the use of “Photo detector” as opposed to the use of “plurality of photo detecting means”, wherein the “control means selects one of the plurality of light emitting means which are associated with the converging optical systems” as amended by applicant to overcome the prior art rejection. Thus reissue claims are indeed broader than the subject matter surrendered during the prosecution of the ‘581 patent..

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25, 27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishiuchi et al (5097464).

The reference shows an optical disk reading and recording apparatus having N type optical disks with variable thicknesses as shown by element 10 and figs 5a and 5b,

emitting a light beam 3, converging the light beam into one of the disk type fig 1 employing an converging optical system 9, 11, 17, and 7. The optical system having at least one of (alternative limitation wherein only one the limitation could be shown to meet the claimed invention) different focal distances as shown by fig 2a-2c being selected by element 11 controlled by element 16. Photo detection means 15.

With respect to the limitation of claim 27 see figs 5a and 5b.

With respect to the limitation of claim 29 see elements 15 and 16.

Any inquiry concerning this communication should be directed to NABIL Z HINDI at telephone number (703) 308-1555.



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